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11764 7590 06/07/2011 Ditthavong Mori & Steiner, P.C. 918 Prince Street Alexandria, VA 22314			EXAMINER CASCA, FRED A	
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ADDENDUM TO ADVISORY

Rejection of claims under 35 USC 112, first paragraph

1. In view of applicant's arguments and reasons, the rejection of the claims under 35 USC 112, first paragraph is withdrawn.

Rejection of claims under 35 USC 103(a)

2. Applicant's arguments with respect to the rejection of claims under 35 USC 103(a) has been considered but they are not persuasive for the reasons provided below. Accordingly, the rejection of the claims under 35 USC 103(a) is maintained.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, the examiner asserts that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The examiner asserts that the examiner's 103(a) rejection is based three basic concepts. Pelaez teaches the primary concepts of multimedia communication between mobile devices via a network including the transmitting, storing and receiving of multimedia messages of the claimed invention (see the art rejection of the claims) and the applicant has not rebutted the rejection with regards to Pelaez. The deficiency of Pelaez with respect to recording of voice message with the multimedia is taught by Hymel (which the applicant has not contested). An artisan would understand such combination is rationale for several reasons, e.g., recording voice with

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multimedia (which is conventional in multimedia technology) would provide explanations or instruction in voice format for a multimedia clip. Thus, such combining would yield predictable results. With regards to combining Pelaez or the combination with Castell, an artisan would understand that such combination is a simple substitution of one known element for another to obtain predictable results. Further, based on a broadest reasonable interpretation of the claim limitation, “**determining to,**” an artisan would be able to try to find out if the multimedia message can be transmitted to a voice mail box. Therefore, it would be obvious to try replacing a known technique with a substitute element to determine if it works and to try obtaining predictable results. Accordingly, based on a broad reasonable interpretation of the claims and the understanding of an ordinary skilled in the art, the rationale for combining the cited prior art references has been established.

4. Applicant further argues on page 10 of the remarks that, “Pelaez in view of Hymel and Castell would not have rendered obvious the combination of features recited in independent claims 1, 8, 16 and 17, including the variously recited feature, *determining to transmit the multimedia message to a voice mail box associated with the telephone number.*; The Office Action acknowledged that Pelaez fails to teach a voice mail box associated with a telephone number. Office Action, page 5. The Office Action alleged that Castell cures Pelaez deficiency because Castell allegedly teaches a voice mail box associated with a telephone number in order for call receiving devices to obtain messages stored for them. Office Action, page 5. Thus, the Office Action merely alleged that Castell discloses the concept of a voicemail box. The Office Action failed to address that the above recited feature of independent claims 1, 8, 16 and 17 recites, “transmit the multimedia message to a voicemail box” and either one or both of Pelaez

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with Castell fails to teach this feature. Importantly, Pelaez discloses that a multimedia mail message is stored at a multimedia- based answering system 200. Pelaez, paragraph [0026]. One of ordinary skill in the relevant art would not consider that the multimedia-based answering system 200 constitutes a voicemail box. Nor would one of ordinary skill in the art consider that a multimedia mail message constitutes a voice mail. Castell merely discloses a voice mail box that stores voice mails.”

The examiner respectfully disagrees with applicant on the above arguments.

As a preliminary matter, it is not clear if the claimed **transmitting of the multimedia** actually does take place to the voice mail box. The examiner asserts that “determining to transmit” is not the same as “transmitting” based on a broad reasonable interpretation of the claims. Thus, the device itself or the user of the device of Pelaez and/or Castell may determine to transmit a multimedia message to a voice mailbox without the actual function of transmitting. The applicant is encouraged to remove the limitation, “determining” from the claim language in order to provide the claimed limitation with distinct purpose for transmitting.

Further, the examiner asserts that the Pelaez teaches the transmitting of multimedia messages to a multimedia mailbox (see rejection of claim 1). With regards to Castell, the applicant’s attention is directed to Column 3, line 63 to Column 4, line 6. Castell teaches, in the above citation of columns 3 and 4, that **voice notification is sent to the voice mailbox**. Castell further teaches that **“in an alternative embodiment, this notification can take place through wireless e-mail, short messaging service (SMS), enhanced messaging service (EMS), multimedia messaging service (MMS).”** See column 4, lines 2-5. From the above recitation of Castell an artisan would be able to understand notification message is sent to voice mailbox and

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the notification message may be multimedia format. Therefore, an artisan would be able to conclude that a multimedia message is sent to a voice mailbox. Thus, based on above teachings of Castell, Pelaez and the broadest interpretation of the claims an artisan would be able to combine the prior art elements according to known methods to yield predictable results.

5. The applicant further argues that “The Office Action presumably alleged that it would have been obvious to one of ordinary skill in the art to replace *Pelaez's* multimedia-based answer system 200 with the voicemail box disclosed in *Castell*. However, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, modifying *Pelaez's* system would cause the system to be inoperable for its intended purpose. Specifically, storing multimedia signals in conventional voice mail systems would cause technical compatibility issues because a traditional voice mail system cannot receive multimedia signals as voice mails. Thus, because the proposed modification would render *Pelaez's* system inoperable, there is no suggestion or motivation to make the proposed modification as alleged in the Office Action. Because Hymel fails to cure the deficiency of *Pelaez* and *Castell*, the rejection is improper.”

The examiner respectfully disagrees with the applicant's above arguments for the following reasons:

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

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5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner asserts (contrary to applicant's arguments), that Castell provides sufficient motivation and suggestion for the combination. Castell clearly shows a suggestion of multimedia being sent to a voice mail box. See column 4, lines 2-5. An artisan understanding the recitation, "this notification can take place through wireless e-mail, short messaging service (SMS), enhanced messaging service (EMS), **multi-media messaging service (MMS)**," would be able to recognize that there is a clear suggestion for multimedia being sent to a voice mail box. Thus, based on the general knowledge available to one of ordinary skill in the art, the combination and modification is proper.

6. The applicant further argues that "Specifically, storing multimedia signals in conventional voice mail systems would cause technical compatibility issues because a traditional voice mail system cannot receive multimedia signals as voice mails. Thus, because the proposed modification would render Pelaez's system inoperable, there is no suggestion or motivation to make the proposed modification as alleged in the Office Action. Because Hymel fails to cure the deficiency of Pelaez and Castell, the rejection is improper."

The examiner respectfully disagrees with the applicant on above arguments as well. The examiner asserts that an artisan would understand that "sending a multimedia message to voice mail box" may require format conversion or modification. Even if Castell has not described literally the details of format conversion, an artisan would understand that in today's advances in signal processing that message format conversions is conventional. Further, the clear

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disclosure of a transmitting of multimedia message to a voice mail box by Castell would be sufficient to enable an artisan to recognize that a voice mail box would be able to receive a multimedia message. Thus, the modification would not render the system of Pelaez inoperable, as the applicant has alleged, but instead it would improve the Pelaez system by efficiently using bandwidth and storage space.

7. Applicant's arguments with respect to claim 9 that the cited prior art does not disclose, "wherein the multimedia message includes an identifier indicating that the multimedia message was created automatically," has been considered but it not persuasive. The examiner asserts that based on a broad interpretation of the independent claim 8 (upon which claim 9 depends) the limitation, **"determine to transmit the multimedia message to a voice mail box,"** make the whole step of transmitting multimedia to a voice mail box optional. Thus, an artisan would understand that such transmission may not happen because "determine to transmit" is not the same as "transmit." Thus, the dependent claim limitation following the "wherein" is also optional and it may not happen. Further, an automatic multimedia message would conventionally have attributes to indicate that the message was created automatically, for example, the automatic message may start with a universal greeting or with universal instructions. Thus, it would have been obvious to an artisan to make the claimed modification.

8. With respect to applicant's arguments with respect to claims 5, 18, 19 and 20, the examiner asserts that the references Nemoto (US 2001/0010714 A1), Burg et al (US 7, 212614), Kaplan (US 2004/0215963) and Purdy (US 6,658,254) teach the well-known limitations of claims 5, 18, 19 and 20. The examiner has cited the relevant portions of references Nemoto, Burg, Kaplan and Purdy below. Further, the examiner asserts that based on the broadest

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reasonable interpretation of claims (specifically with regards to the limitation, “determining to”) and the general knowledge of one skilled in the art it would be obvious to combine with Nemoto, Burg, Kaplan and Purdy references, for the purpose of combining well-known elements or concepts to known methods to yield predictable results, particularly since the independent claim does not distinctly claim that the establishing, recording, and determining actually take place.

With respect to claim 5, Nemoto (US 2001/0010714 A1) teaches the well-known concept of transmitting sound clip to a receiver as a response to a confirmation of a message sending function, as in claimed in claim 5 (see Nemoto, Par. 22). With respect to claim 18, the well-known concept of converting a multimedia message to a voice mail (inherently by messaging server) is taught by Burg et al (US 7, 212614). See Burg, column 2, lines 60-65. With respect to claim 19, the examiner asserts that reference Kaplan (US 2004/0215963) teaches the limitations of claim 19 (see Kaplan, Par. 13 and claim 10). Further, the examiner asserts that since the broad limitations of independent claim 1, e.g., “determining to record,” “determining to establish,” and “determining to transmit,” make the associated steps optional and thus the limitation of claim 19 is also optional. Thus, entire limitation, “determining ... a multimedia message,” as in independent claim 1 and the limitation of claim 19 is optional. With respect to claim 20, the examiner asserts that reference Purdy (US 6,658,254) discloses the limitation of claim 20 in Col 9, lines 25-55.

/Fred Casca/

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